REMARKS

The present invention is a method of distributing electronic content between first and second terminal devices, a system for distributing electronic content, a memory module for use with a terminal device and a terminal device. Each of the claims, in differing degrees of scope, substantively requires storing of tailoring information in a memory module separate from and releasably attachable to a terminal device with the tailoring information defining what electronic content is able to be transferred, a period of time during which the defined content is able to be transferred, and whether the defined content can be transferred between terminal devices. Once tailoring information is given its proper narrower construction than the impermissibly broad interpretation thereof by the Examiner of "authorizing" information, the rejection of the claims under 35 U.S.C. §103, as discussed below based at least on the combination of Martineau and Ginter et al, cannot stand.

Claims 1, 3 and 6-18 stand rejected under 35 U.S.C. §103 as being unpatentable over United States Patent 5,892,900 (Ginter et al) and United States Patent 5,915,226 (Martineau). These grounds of rejection are traversed for the following reasons.

With respect to claim 1, the Examiner reasons in part as follows:

> Martineau does not specifically recite the term "tailoring information".
>
> However Ginter clearly teaches (see all above citations, including citations in Response to Arguments section) that control and access codes may be stored on the smart card defining what electronic content may be transferred: what content can be transferred, if it can be further transferred to a third party, if it can be copies, edited, or have its rules of control and access changed prior to further transfer; when the content can be transferred, the period of time during the

content may be accessed, what payment is due for accessing the content, etc., etc. The control and access code may also include, as appropriate, cryptographic keys and digital signatures, for appropriate authentication, verification, and authorization of both parties to the transaction (see both Martineau and Ginter citations above).

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Ginter's teachings to a wireless system as disclosed by Martineau in order to provide convenient, safe, secure, versatile, and portable means for delivering and distributing electronic content, as recited in claim 1.

For reasons set forth below, this reasoning is erroneous.

Claim 1 recites a method of distributing electronic content between first and second terminal devices. A memory module is recited which is separate from and releasably attachable to at least the second terminal device that stores tailoring information "defining what electronic content is able to be transferred, a period of time during which the defined electronic content is able to be transferred" and whether the defined electronic content can be transferred by the second terminal device to a further terminal device". The electronic module is attached to the second terminal device, during which the tailoring information is read from the memory module into the second terminal device followed by comparing the tailoring information in the second terminal device with tailoring information included with the content and if the tailoring information in the second terminal device compares favorably with the tailoring information included with the content, transferring the defined electronic content from the first terminal device to the second terminal device according to the tailoring information. The proposed combination of

Martineau and Ginter et al, if made, does not render this subject matter obvious.

In the first place, Martineau discloses a mechanism by which a cellular telephone handset, which includes a SIM card 4, receives a prepaid card 10 so that a payment from the prepaid card is used to pay for telephone calls when the SIM card and the prepaid card authenticate that there are units in the prepaid card which may be used to pay for the telephone call at which point the SIM card switches to a non-restricted mode allowing the telephone call to be completed. See column 7, lines 66-67, through column 8, lines 1-10. As may be seen, the cellular telephone handset 2 communicates through a base station 12 to presumably another telephone or mobile unit which is not illustrated nor described.

The Examiner erroneously concludes that Martineau discloses the transfer of electronic content. All that Martineau suggests is that a telephone call in a SIM enabled cellular telephone handset is paid for by a prepaid card 10. A person of ordinary skill in the art understands that voice communications, which are digitized content transmitted between the cellular handset 2 and the base station 12, are not electronic content. Electronic content is understood by persons of ordinary skill in the art to consist of digitized non-voice communications.

Moreover, it is understood that the Examiner has construed the SIM card 8 to be the storage for tailoring information. However, since tailoring information is specifically recited in claim 1 as "storing tailoring information in

a memory module separate from and releasably attachable to the second terminal device, the tailoring information defining what electronic content is able to be transferred, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred by the second terminal device to a further terminal device", the SIM card must contain the tailoring information. Moreover, it is seen that claim 1 recites the interaction between three terminal devices with tailoring information being stored in a memory module which is attachable to the second terminal, device which the Examiner must construe to be the cellular telephone handset. The Examiner has not accounted for the two other terminal devices in the rejection of claim 1.

Moreover, it is clear that the SIM card 8 does not satisfy any of the attributes of the stored tailoring information which the Examiner must construe to be present on the smart card 8 in order to meet claim 1.

The SIM module described in Martineau has the attributes of SIM in the GSM system which has the purpose of enabling a user to personalize mobile equipment so that it may be used with particular SIMs. This usage is not analogous to the recited storing of tailoring information on a memory module.

It is noted that the Examiner has construed "tailoring information" as "authorizing" information which is a far broader construction than the tailoring information as specifically recited in claim 1. While a SIM card 8, as taught by Martineau, might have an "authorizing" function, it does not have anything

analogous to the recited tailoring information stored thereon. The Examiner has impermissibly broadened the construction of tailoring information as recited in claim 1.

Moreover, claim 1 specifically recites "while the memory module is attached to the second terminal device, reading the tailoring information from the memory module into the second terminal device". The Examiner cites column 4, lines 17-38, of Martineau. However, what is disclosed is not tailoring information as recited in claim 1, but merely pertains to the transfer of prepaid telephone units to the SIM card which does not meet the limitation of reading tailoring information and electronic content from the memory module into the second terminal device. Prepaid telephone units, while possibly being a form of authorizing information, do not meet the recited definition of tailoring information.

Moreover, the Examiner's citation of Ginter et al at column 41, lines 5-7, is not understood to address or suggest the transfer of tailoring information from the memory module into a second terminal device or electronic content. All that is stated in column 41 of Ginter et al is that "[t]he VDE card and the terminal (and/or online connection) can securely exchange information related to a transaction, with credit and/or electronic currency being transferred to a merchant and/or clearinghouse and transaction information flowing back to the card". This has nothing to do with the specific recitation of the memory module being attached to the second terminal device

to read the tailoring information and electronic content from a memory module into the second terminal device.

Moreover, claim 1 further recites, "comparing the tailoring information in the second terminal device with the tailoring information included with the content". Apparently the Examiner is relying upon Martineau at column 4, lines 17-38, and Ginter et al at column 41, lines 5-7. However, neither Martineau nor Ginter et al describe comparing tailoring information in the second terminal device with tailoring information included within the content. The Examiner has not explained where tailoring information associated with the content is found in the references and what the source of the content is. Certainly, with respect to Martineau, since the information which is transmitted is digitized audio, there is no "tailoring information included with the content" which is compared with the tailoring information in the second terminal device. Moreover, the reference to column 41, of Ginter et al does not cure the foregoing deficiencies.

Finally, claim 1 recites if the tailoring information in the second terminal device compares favorably with the tailoring information included with the content, transferring the defined electronic content from the first terminal device to the second terminal device according to the tailoring information. In this regard, the Examiner has not explained where the first terminal device is located in Martineau or in Ginter et al. It should be noted that the previous portion of claim 1 required the memory module to be attached to the second terminal device which had to be under the Examiner's construction of claim 1

to be the cellular telephone handset 2. With this construction in mind, the Examiner has not indicated where in Martineau and/or Ginter et al alone or in combination the transferring of defined electronic content from the first terminal device to the second terminal device according to the tailoring information occurs "if the tailoring information in the second terminal device compares favorably with the tailoring information included with the content".

In Section 6C of the Office Action, the Examiner has commented upon the Ginter et al reference. Therein it is noted that the Examiner refers to several places in Ginter including columns 299-302 with reference to lines 14-33 of column 299, lines 42-59 of column 299 and lines 3-15 of column 302, and furthermore to columns 307-332. The Examiner is correct that distribution of virtual distribution environment (VDE) is described. However, the described distribution does not pertain to the specifics of the claimed environment involving multiple terminal devices and the storing of tailoring information in a memory module which, as claimed, is attached to the second terminal device as part of the process for tailoring information to be transferred to the second terminal device, compared therein and if the comparison is favorable, to transfer electronic content from a first terminal device to the second terminal device. This sequence, and nothing analogous thereto, is disclosed in the aforementioned portions of Ginter et al.

Moreover, it is submitted that the Examiner has not demonstrated any motivation why a person of ordinary skill in the art would be motivated to modify Martineau which, contrary to the Examiner's position in the final

rejection, does not disclose transfer of electronic content to include the distribution of electronic content between multiple terminal devices as recited in claim 1 pertaining to a memory module which is a SIM card as disclosed in Martineau. Clearly, Martineau does not contemplate distribution of electronic content in any manner analogous to the subject matter of the claims involving multiple terminal devices with Martineau's disclosure being concerned with the payment from a pre-payment card 10 to a SIM card 8 mounted in the cellular telephone handset 2.

It is submitted that a person of ordinary skill in the art would not consider either Martineau's use of SIM card 8 or Ginter et al's VDE system, which does not disclose the use of memory modules with tailoring information as recited in claim 1, including the reading of the memory module to transfer tailoring information to the second terminal device as recited in claim 1, to be combinable to achieve the subject matter of claim 1. It is submitted that the Examiner's proposed combination is based on impermissible hindsight with the Examiner picking and choosing various features from Martineau and Ginter et al proposed combination to achieve the subject matter of claim 1. There is no counterpart of the multiple terminal devices and storage of tailoring information in the memory module including its use thereof as recited in claim 1 in the Martineau and Ginter et al references.

Claim 15 defines a system for distributing electronic content. Claim 15 recites an element for transferring selected electronic content over the wireless connection according to predetermined tailoring information defining

electronic content eligible to be transferred from the element, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred by a first terminal device to a further terminal device; a first terminal device for receiving electronic content over the wireless connection; a memory module for storing tailoring information, the memory module being separate and releasably attachable to the first terminal device; attaching means for attaching the memory module to the first terminal device; the first terminal device being adapted to read the tailoring information from the memory module and to transmit the tailoring information to the element over the wireless connection; and the element being adapted to transfer electronic content to the first terminal device over the wireless connection according to the tailoring information. The arguments involving the combination of Martineau and Ginter et al and limitations which are common to claims 1 and 15 are incorporated by reference. It is submitted that claim 15 is not rendered obvious by the proposed combination of Martineau and Ginter et al.

Claim 15 substantively recites that the first terminal device is adapted to read the tailoring information from the memory module and to transmit the tailoring information to the element over the wireless connection with the element transferring selected electronic content over the wireless connection according to predetermined tailoring information defining electronic content eligible to be transferred from the element, a period of time during which the defined electronic content is available to be transferred, and whether the

defined electronic content can be transferred via a first terminal device to a further device. As has been pointed out above with respect to claim 1, the Martineau system does not pertain to the transmission of electronic content in accordance with tailoring information including whether the defined electronic content can be transferred via a first terminal device to a further terminal device. All that Martineau discloses is a portable handset 2 communicating with a base station 12. The Examiner has not explained what he considers the claimed "element" to be and, like the rejection of claim 1, the Examiner interprets tailoring information to be mere "authorizing" without giving weight to the recited specifics of the tailoring information including defining electronic content eligible to be transferred from the element, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred via a first terminal device to a further device. Moreover, the deficiencies of the interpretation of the SIM card 8 as being the memory module for storing tailoring information have been discussed above with respect to claim 1.

Furthermore, the first terminal device is recited as being adapted to read the tailoring information from the memory module and to transmit the tailoring information to the element over the wireless connection. The Examiner has not explained where the element is (which is not recited in claim 1), and how the cellular telephone handset 2 could be read upon the first terminal device, including transmitting tailoring information which has been transferred thereto from the memory module and to transmit the

tailoring information to the element which the Examiner has not even addressed in the Final Rejection.

It is submitted that Ginter does not disclose the combination of the element for transferring electronic content over a wireless connection according to predetermined tailoring information as recited in claim 15 in combination with the memory module transmitting the tailoring information to the first terminal device and further transmitting the tailoring information to the element over the wireless connection.

Martineau does not disclose the transmission of anything from the SIM card 8 over the wireless connection and therefore, cannot be read upon the transmission of tailoring information which has to be interpreted by the Examiner as being stored on the SIM card 8.

In summary, it is submitted that the Examiner has not considered the limitations of claim 15 which are substantively different than the limitations in claim 1. Moreover, like claim 1, claim 15 recites tailoring information which controls whether the defined electronic content can be transferred between terminal devices with the tailoring information being stored on a memory module which has no counterpart in the proposed combination of Martineau and Ginter et al.

It is submitted that the Examiner's proposed combination of Martineau and Ginter et al is based upon impermissible hindsight and if such a combination were made, it would not result in the claimed invention in that a person of ordinary skill in the art would not consider the combined teachings

of Martineau and Ginter et al to suggest the use of multiple terminal devices and the storage medium as recited in claim 15.

Claim 16 defines a memory module for use with a terminal device with the memory module comprising a storage medium for storing tailoring information relating to specific electronic content that the memory module authorizes to be transferred to the terminal device, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred by the terminal device to a further device; and an interface for mechanically and electrically coupling the memory module to the terminal device, the memory module being releasably attachable by the user to the terminal device to bring the memory module into mechanical and electrical content with the terminal device. The Examiner has rejected claim 16 on the same grounds as set forth above with respect to claim 1. The arguments involving the combination of Martineau and Ginter et al and the limitations which are common to claims 1 and 16 are incorporated herein by reference.

The rejection of claim 16 is traversed for the reason that the proposed combination does not disclose the claimed storage medium including storing tailoring information which defines how specific electronic content is authorized to be transferred to the terminal device and further, a time period during which the defined electronic content is being transferred and whether the defined electronic content can be transferred by the terminal device to a further device. As has been stated above, there is no disclosure in the

combined teachings of Martineau and Ginter et al for transferring electronic content between terminal devices including tailoring information stored in a detachable memory module which authorizes electronic content to be transferred to the terminal device and whether the defined electronic content can be transferred by the terminal device to a further terminal device. As stated above, neither Martineau nor Ginter et al alone or in combination suggests the multiple terminal devices in combination with tailoring information stored in the memory module for controlling whether the defined electronic content can be transferred to a third terminal device.

It is submitted that the Examiner's proposed combination of Martineau and Ginter et al is based upon impermissible hindsight and if such combination were made, it would not result in the claimed invention in that a person of ordinary skill in the art would not consider the combined teachings of Martineau and Ginter et al to suggest the use of multiple terminal devices and the storage medium as recited in claim 16.

Dependent claims 3 and 6-14 and 17-18 define more specific aspects of the present invention which are not rendered obvious by the proposed combination of Ginter and Martineau.

Claims 4-5 and 19-31 stand rejected under 35 U.S.C. §103 over Ginter in view of Martineau further in view of WO 00/18025 (Nokia). This ground of rejection is traversed for the following reasons.

With respect to dependent claims 4 and 5, it is noted that Nokia is cited for disclosing low power radio frequency RF links which does not cure the

deficiencies of the basic combination of Martineau and Ginter as discussed above. Claim 5 also is patentable for the same reasons as set forth above with respect to claim 4.

Claim 19 defines a terminal device including a storage device for storing tailoring information, the tailoring information defining specific electronic content that the storage device authorizes as being transferable to the terminal device, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred by the terminal device to a further terminal device; an interface for mechanically and electrically coupling the storage device to the terminal device, the interface allowing releasable attachment of the storage device by a user to the terminal device to bring the storage device into mechanical and electrical contact with the terminal device; means for reading the tailoring information from the storage device into the terminal device when the storage device is in mechanical and electrical contact with the terminal device; and the transceiver for transmitting the tailoring information by wireless communication in order to authorize transfer of the specific electronic content to the terminal device. Claim 19 is patentable for the same reasons noted above with respect to claim 16. It is submitted that Nokia, which has been cited for a portable communications device capable of establishing a short range, low power radio frequency link, does not cure the deficiencies noted above with respect to the rejection of claim 16.

Claim 20 defines a method of distributing electronic content between first and second terminal devices which includes storing tailoring information in a memory module separate from and releasably attachable to the first terminal device and the second terminal device, the tailoring information defining what electronic content is able to be transferred, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred by the second terminal device to a further terminal device; attaching the memory module to the first terminal device; while the memory module is attached to the first terminal device, reading the tailoring information into the first terminal device; transferring electronic content from an access point to the first terminal device according to the tailoring information; attaching the electronic module to the second terminal device; while the memory module is attached to the second terminal device, reading the tailoring information from the memory module into the second terminal device; and transferring the electronic content from the first terminal device to the second terminal device according to the tailoring information. The arguments involving the combination of Martineau and Ginter et al and the limitations which are common to claims 1 and 20 are incorporated by reference. It is submitted the proposed combination of Martineau and Ginter and Nokia does not suggest the storing of tailoring information in a memory module which is attachable to first and second terminal devices. As noted above, the Examiner has not provided any explanation where in the proposed combination of Martineau and Ginter et al

first and second terminal devices are present. Moreover, Nokia does not cure this deficiency.

Furthermore, claim 20 is limited to the attachment of the memory module to first and second terminal devices which results in the tailoring information being read from the memory module into the first and second terminal devices followed by transferring the electronic content from the first terminal device to the second terminal device according to the tailoring information. As has been discussed above with respect to claim 1, it is submitted that the proposed combination of Martineau and Ginter et al does not suggest the specific steps recited in claim 20 including the transfer of electronic content from the first terminal device to the second terminal device according to the tailoring information.

Claim 21 recites a method of distributing electronic content between first and second terminal devices including storing tailoring information in a memory module separate from and are releasably attachable to the first terminal device, the tailoring information defining what electronic content is available to be transferred, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred back to the second terminal device to a further terminal device; while the memory module is attached to the first terminal device, reading the tailoring information from the memory module into the first terminal device; transferring electronic content from an access point to the first terminal device according to the tailoring information and

transferring the electronic content from the first terminal device to the second terminal device according to the tailoring information. The arguments involving the combination of Martineau and Ginter and limitations which are common to claims 1 and 21 are incorporated by reference. In the first place, claim 21 recites that the tailoring information determines whether the defined electronic content can be transferred to the second terminal device to a third terminal device. It is submitted that the proposed combination of Martineau, Ginter et al and Nokia does not suggest first, second and third terminal devices. It should be noted that the Examiner has not explained where the first, second and further terminal devices are in the proposed combination of Martineau, Ginter et al and Nokia. Furthermore, it is submitted that the proposed combination does not suggest the reading of tailoring information from a memory module into a first terminal device transferring electronic content from an access point to the first terminal device and transferring the electronic content from the first terminal device to the second terminal device.

Claim 22 defines a method of distributing electronic content between first and second terminal devices. Claim 22 is patentable for the same reasons set forth above with respect to claim 21. Claim 22 differs from claim 21 in reciting that the memory module is attached to the second terminal device followed by reading the tailoring information from the memory module into the second terminal device; transferring electronic from an access point to the first terminal device according to the tailoring information; and transferring the electronic content from the first terminal device to the

second terminal device according to the tailoring information. While step (c) of claim 22 pertains to the second terminal device and step (c) of claim 21 pertains to the first terminal device, it is submitted that claim 22 is patentable for the same reasons set forth above with respect to claim 21.

Claim 23 recites a method of distributing electronic content between first and second terminal devices. Claim 23 recites storing of tailoring information in a first memory module separate from and releasably attachable to the first terminal device, the tailoring information defining what electronic content is able to be transferred, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred by the second terminal device to a further terminal device followed by the sequence of attaching the first memory module to the first terminal device and reading the tailoring information from the first memory module into the first terminal device; storing the tailoring information in the second memory module separate from and releasably attachable to a second terminal device; attaching the second memory module to the second terminal device and reading the tailoring information from the second memory module into the second terminal device, comparing the tailoring information of the first terminal device with the tailoring information of the second terminal device and if the tailoring information in the first terminal device compares favorably with the tailoring information in the second terminal device, transferring the defined electronic content from the first terminal device to the second terminal device according to the tailoring

information. It is therefore seen that claim 23 is substantially more limited than the preceding claims in defining not only a first memory module, but also a second memory module, the transmission of tailoring information from the first memory module and the second memory module respectively to first and second terminal devices followed by comparing the tailoring information from the first terminal device with the tailoring information of the second terminal device; and upon favorable comparison, transferring the defined electronic content from the first terminal device to the second terminal device according to tailoring information. Claim 23 recites multiple terminal devices which interact with multiple memory modules including comparing of the tailoring information in the multiple terminal devices with a successful comparison resulting in the transferring of the defined electronic content from the first terminal device to the second terminal device. This combination is clearly not taught by the proposed combination of references. As has been stated above with respect to claim 1, the proposed combination of references does not even suggest conditions under which the storage of electronic content on a single memory module would be used to control transferring of defined electronic content from a first terminal device to a second terminal device according to the tailoring information. Moreover, there is no counterpart of the claimed usage of multiple memory modules and their interaction with multiple terminal devices.

It is noted that the Examiner merely concludes that "[u]sing the obviousness and motivation analysis and the citations already made for

claims 1, 15, 16 and 19, Ginter in view of Martineau and Nokia disclose all of the limitations of claims 23-24". It is submitted that this analysis is incorrect with the Examiner not even providing any indication where the multiple terminal devices and the multiple memory modules are as recited in claim 23 in his analysis of claim 23. It is submitted that the rejection of claim 23 is based upon impermissible hindsight and if the proposed combination of references were made, as suggested by the Examiner, the result would not achieve the subject matter of claim 23.

Claim 24 defines a method of distributing electronic content between first and second terminal devices. Claim 24 is patentable for the same reasons set forth above with respect to claim 22.

The rejected dependent claims further limit the independent claims in a manner which is not rendered obvious by the proposed combination of Martineau, Ginter et al and Nokia.

In view of the foregoing remarks, it is submitted that each of the claims in the application is in condition for allowance. Accordingly, early allowance thereof is respectfully requested.

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Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 0171.39361X00), and please credit any excess fees to such deposit account.

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